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09/594,445	06/15/2000	Beth N. Grijalva	GRIJ-0002-US	8014

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EXAMINER

HAMILTON, LALITA M

ART UNIT PAPER NUMBER

3624

DATE MAILED: 06/29/2004

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/594,445
Filing Date: June 15, 2000
Appellant(s): GRIJALVA, BETH N.

Fred G. Pruner
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed May 9, 2003.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes a statement that claims 1-56 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

1,310,077	Heaford	7-1919
4,582,401	Grindle	4-1986
2,687,524	Mosher	8-1954

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-11, 13-25, 27-41, and 43-45 are rejected under 35 U.S.C. 102(b) as being anticipated by Heaford ('077).

Heaford discloses a flexible body formed of a pliable material and adapted to partially extend over the lens and along side the arm (col.1, lines 45-55) and (7), first and second fasteners (12), eyeglass frames, a lens socket (col.2, lines 70-95), a first fastener comprising a loop having first and second ends (12)(second end may be interpreted as being a pronged tab), a releasable connector (17), and a body having at least one slot (10). The method of intended use is not given patentable weight in the article claims.

Claims 46-48 and 52-56 are rejected under 35 U.S.C. 102(b) as being anticipated by Grindle.

Grindle discloses an eye patch for use with eyeglasses comprising a flexible body having a first portion (24) and second portion (22), which block the frontal and peripheral vision of the eye (col.2, lines 4-6), the portions being opaque (col.4, lines 64-

66), the second portion adapted to extend partially along the side arm (fig.1), and the first and second portions together forming a loops that extend around the bridge and side arm to attach both to the body (fig.1).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 12, 26, and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Heaford in view of Grindle ('401).

Heaford discloses the invention substantially as claimed; however, Heaford does not disclose a fabric material or a fastener comprising a tab that is separate from the body. Grindle teaches a lens occluder comprising a fabric material and attaching means (col.3, lines 35-40). It would have been obvious to one having ordinary skill in the art at the time the invention was made to form the tab separate from the body and incorporate that in place of the attachment means disclosed by Heaford, since it has been held that constructing a formerly integral structure in various elements involves only routine skill in the art. *Nerwin v. Erlichman*, 168 USPQ 177, 179.

Claims 49-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Grindle in view of Mosher (2,687,524).

Grindle discloses the invention substantially as claimed; however, Grindle does not disclose the first fastener comprising a loop having a first end secured to the body

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and a second end adapted to extend around the bridge and releasably couple the bridge to the body, a releasable connector adapted to releasably couple the side arm to the body, or a second fastener comprising a loop adapted to extend around the side arm, wherein the loop has a first end secured to the body and a second end. Mosher teaches a removable eyeshade for eyeglasses comprising a first fastener forming a loop (fig.2-3: 32), a releasable connector (30), and a second fastener forming a loop (31), wherein the loop has a first end secured to the body and a second end. It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the first fastener comprising a loop, a releasable connector, and a second fastener comprising a loop as taught by Mosher onto the device disclosed by Grindle to provide a separate and alternative fastening means.

(11) Response to Argument

The Appellant argues that Heaford fails to disclose an eye protector substantially blocking both frontal and peripheral vision of an eye. In response, the Appellant claims "a flexible body to be positioned on a front of the frames to substantially block both frontal and peripheral vision of an eye". The Examiner interpreted "to be positioned on a front of the frames to substantially block both frontal and peripheral vision of an eye" in the article claim as being intended use, since "to be" may be interpreted as meaning that it may be placed in such a position. The Appellant did not claim the method of doing so in claim 1, thus the Examiner contends that Heaford reads onto the invention substantially as claimed.

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With regard to claims independent claims 16, 30, 34, and 39, the Appellant argues once again that Heaford does not disclose the eye protector substantially blocking both frontal and peripheral vision of an eye. For the same reasons above, the Examiner contends that Heaford reads onto the invention substantially as claimed.

With regard to independent claim 46, the Appellant argues that Grindle does not disclose a flexible body having a second portion to substantially block peripheral vision of an eye. In response, Grindle discloses what the Examiner has interpreted as a flexible body having a second portion to substantially block peripheral vision of an eye (22) and (col.2, lines 4-6). Grindle discloses that the device is used for occluding the visual field of the eye. Therefore, the Examiner is interpreting Grindle as reading onto the invention substantially as claimed. Further, the Appellant incorrectly argues that the Examiner refused to give any patentable weight to the limitations of claim 46. In response, the Examiner did give patentable weight to **all** limitations in independent claim 46 by citing support for her position in the rejection.

With regard to independent claim 52, the Appellant again incorrectly argues that the Examiner has given no patentable weight to the limitations set forth in the claim and that the Examiner did not specifically address the limitations of the claim. In response, the Examiner did in fact give patentable weight to all limitations of claim 52. The Examiner did **not** cite intended use against claim 52, which is a method claim. In the Final Office Action, the Examiner addressed newly added claims 52-56 by rejecting them as being anticipated by Grindle. Further in the arguments of the Final Office

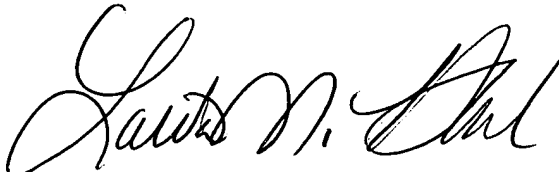
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Action, the Examiner did **not** state that she was giving no patentable weight to the method claims.

The Appellant argues that the 112 second paragraph rejection set forth fails to give proper reasoning for rejecting claims 2-3. In response, the Examiner pointed out in both the Non-final and Final Office Actions that merely claiming that the eye patch is usable with eyeglass frames in the preamble does not mean that eyeglass frames is a positively recited limitation. Eyeglass frames should be cited in the body of the claim in order to provide the eyeglass frames cited in claims 2 and 3 with support.

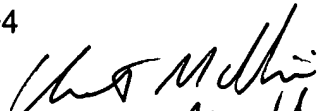
For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

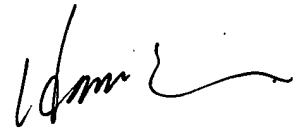


Lalita M. Hamilton
June 28, 2004

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